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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PREVIL, DANIEL

ART UNIT

PAPER NUMBER

2632

DATE MAILED: 12/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/751,468

Applicant(s)

STEFANIK, JOHN R.

Examiner

Daniel Previl

Art Unit

2632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 and 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This action is responsive to communication filed on October 23, 2002.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-9, 11 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 1, the phrase " wherein the light source has no visual display function" in line 7, considered as a new matter because it was not described in the specification.

Regarding claim 6, the phrase " no output function" in line 10 considered as a new matter because it was <sup>Not</sup> described in the specification.

Regarding claim 8, the phrase " and wherein the plurality of lights do not backlight the plurality of keys" in line 11 considered as a new matter because it was not described in the specification.

Regarding claim 11, the phrase “while not disabling the remote control device” in line 11 considered as a new matter because it was not described in the specification.

Claims 2-5, 7, 9 are rejected for the same reason since they depend from rejected claim.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 6, 8, 11, are rejected under 35 U.S.C. 102(b) as being anticipated by Darbee et al. (US 6,002,450).

Regarding claims 1, 6, Darbee teaches a housing 10 (fig. 1); a processor located in the housing (microcontroller 28 located in the housing 10) (fig. 2, ref. 28) ; at least

one input device in communication with the processor (keyboard 38 connected to the microprocessor 28) (fig. 2, ref. 28, 38; col. 5, lines 7-8); and a light source attached to a top side of the housing and in communication with the processor (on a top panel 12, LCD visual display 14 communicates with the microcontroller 28) (fig. 2, ref. 28, 12, 14; col. 4, lines 63-67; col. 5, lines 1-6); wherein the motion detector communicates to the processor upon detection of motion of the device and the processor effects the light source to be lit upon receipt of the signal (a motion detector determines if the user picked up the remote control, a payload message can come up to the LCD 14 to indicate the current status of the remote control, the microcontroller 28 effects the LCD 14 to display a message) (fig. 2; col. 3, lines 33-38; col. 8, lines 9-11). Claim 6 adds the limitation: a semi-transparent area located on a top side of the housing and having no input function wherein the semi-transparent area is backlit when the light source is lit (back-lighting provide illumination for the visual display 14 or keys on the keyboard 15) (col. 6, lines 44-45; col. 7, lines 3-5).

Regarding claim 2, Darbee teaches an input device which is a keyboard (col. 5, lines 7-8).

Regarding claim 8, Darbee teaches a housing 10 (fig. 1); a processor located in the housing (microcontroller 28 located in the housing 10) (fig. 2, ref. 28); a keypad located on a top side of the housing and in communication with the processor (visual display 14 can include a touch-

sensitive display screen or touch sensitive pads/keys on the back of the remote control 10 beneath the visual display 14 which is on top of the housing) (col. 7, lines 3-5); keypad having a plurality of keys (col. 7, line 4); and a plurality of light attached to a top side (a plurality of lights are inherently included in the plurality of keys in the keypad) (col. 7, lines 3-5) of the housing and in communication with the processor (fig. 2) each of the lights corresponding to at least one of the keys (col. 7, lines 3-5); wherein motion detector communicates a signal to the processor upon detection of motion of the device and wherein the processor effects the plurality of lights to be lit upon receipt of the signal (a motion detector determines if the user picked up the remote control, a payload message can come up to the LCD 14 to indicate the current status of the remote control, the microcontroller 28 effects the LCD 14 to display a message) (fig. 2; col. 3, lines 33-38; col. 8, lines 9-11; col. 7, lines 3-5).

Regarding claim 11, Darbee teaches all the limitations set forth in claims 1, 6, 8, 10 and Darbee further teaches a user-controllable switch in communication with the light source for disabling the lighting of the light source (driver 44 communicates with the LCD display, the remote control 10 is off) (col. 6, lines 5-7).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3-5, 7, 9, are rejected under 35 U.S.C. 103(a) as being unpatentable over Darbee in view of Vernace (US 5,648,757).

Regarding claim 3, Darbee teaches all the limitations in claim 1 but fails to explicitly teach a mercury switch.

However, Vernace teaches a mercury switch (col. 5, lines 20-21).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Vernace in Darbee. Doing so would provide the user with the capability of finding easily a lost or misplaced remote control device.

Regarding claim 4, Darbee discloses a storage area in communication with the processor (fig. 2, ref. 28, 36).

Regarding claim 5, the above combination discloses all the limitations in claim 1 and Vernace further teaches the light source which is a fluorescent light (col. 4, line 49). Same motivation in claim 1.

Regarding claim 7, Darbee discloses a semi transparent area includes a border located on the top side of the housing (fig. 1, ref. 14).

Regarding claim 9, the examiner takes the official notices that " a plurality of LEDs " is well known in the art.

### ***Response to Arguments***

6. Applicant's arguments filed on October 23, 2002 have been fully considered but they are not persuasive.

According to Applicant's argument on page 4 "Darbee does not teach or suggest a light source attached to a top side of the housing and in communication with the processor, wherein the light source has no visual display function, wherein the motion detector communicates a signal to the processor upon detection of motion device and wherein the processor effects the light source to be lit upon receipt of the signal" The added amendment like "light source has no visual display function" was not described in the specification, so it is a new matter. Applicant's invention on page 6 first paragraph stated that " light source could be any lighting means" Darbee discloses a motion detector that determines when the user pickup the remote control, the microcontroller effects the LCD which is lit to display a message) (col. 6, lines 54-61).

Contrary to Applicant's argument, Darbee discloses a semi-transparent area located on topside of the housing and having no input function (fig. 1, ref. 14). Darbee discloses a plurality of lights via a plurality of keyboard keys (fig. 1).



For at least the above reason, the rejection of claims 1-9, 11 is sustained.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Conclusion***

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Darbee et al. (US 6,278,499) discloses a two-way remote control with advertising display.

Feinleib et al. (US 6,346,891) discloses a remote control system with handling sensor in remote control device.

Darbee et al. (US 6,130,726) discloses a program guide on a remote control display.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Previl whose telephone number is 305-1028. The examiner can normally be reached on Monday-Thursday.

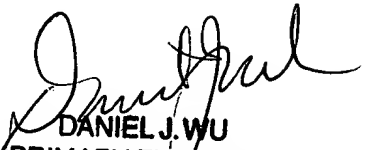
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel WU can be reached on 703 308 6730. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9315 for regular communications and 703 872-9314 for After Final communications.

Art Unit: 2632

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-4700.

Daniel Previl  
Examiner  
Art Unit 2632

DP  
December 17, 2002

  
DANIEL J. WU  
PRIMARY EXAMINER  
12/27/02